

### **Remarks/Arguments**

These remarks are in response to the final Office Action dated May 5, 2004. At the time of the Office Action, claims 23-38 were pending in the application. Claims 28-30 and 39 as originally numbered were rejected under 35 U.S.C. §112, second paragraph. Claims 23, 25-26, 30-31 and 33-35 were rejected under 35 U.S.C. 102(b). Claims 24, 32, and 36-37 were rejected under 35 U.S.C. 103(a). The rejections are set out in more detail below.

#### **I. Claim Objections**

The Examiner has objected to the claim numbering, noting that misnumbered claims 27-39 have been renumbered as 26-28. The numbering error appears to have been caused by the inadvertent omission of claim 26 as originally numbered. In order to correct this deficiency, new claim 39 has now been added to replace the omitted claim. New claim 39 is dependent from claim 23. The renumbered claims have now been amended to recite proper dependency. Similarly, the dependencies of claims 32-38 have now been corrected to be consistent with the renumbering of the other claims.

#### **II. Claim Rejections**

Claims 28-30 and 39 were rejected under 35 U.S.C. §112, second paragraph. The Examiner has noted that claims 28-30 improperly depend on nonexistent claim 26. In response, new claim 39 has now been added, and the dependencies of claims 28-30 have been corrected to depend on new claim 39. The Examiner also objected to claim 39 (now renumbered as claim 38) because that claim improperly depended on canceled claim 1. In response, the dependency of claim 38 has now been amended to depend from claim 31.

### III. Brief Review of Applicants' Invention

Prior to addressing the Examiner's rejections on the art, a brief review of Applicant's invention is appropriate. The invention is directed to a method and system for allowing a user to conveniently create a list of programs to be played by selecting from among a plurality of existing programs contained on an existing program list. The list of programs to be played can be provided with an identifier so that it can be selected as an item from a menu. The process is made convenient and straightforward for the user because the existing program list identifies each program using a title that refers to the subject matter or artistic content of a recorded performance. The foregoing approach is distinguishable from conventional prior art editing systems that identify selected video segments for editing by using generic names or coded file identifiers that would not be suitable to inform an average user of the artistic content contained therein.

### IV. Claim Rejections on Art

Claims 24, 32, and 36-37 were rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent No. 6,181,870 to Okada, et al. However, Okada, et al. discloses a video editing system that is intended for modification of video content down to the cell level. See Okada, Fig. 77B which shows a plurality of cells displayed and ready for editing. In DVD-Video, a cell is a group of pictures or audio blocks. Each cell is assigned a unique cell ID number and is the smallest addressable portion of video stored on the media. The cell ID numbers are not descriptive of the subject matter or artistic content of a recorded performance. Accordingly, they would be cumbersome at best for the purposes of creating a program play list.

Similarly, in DVD-Video it is well known that a video title typically contains up to 999 program chains (PGCs) of the kind that are illustrated in Okada's Fig. 77A. Each program chain or PGC contains up to 99 ordered collections of pointers to cells. Like the cell ID, however, PGCs are typically given generic number identifiers that are not

descriptive of the subject matter or artistic content of a recorded title. In view of the foregoing, it is apparent that the video editing methods disclosed in Okada et al. would not anticipate Applicant's claimed invention for creating user selectable play lists based on titles that are descriptive of the subject matter or artistic content of a recorded performance.

Claims 24, 32, and 36-37 were rejected under 35 U.S.C. 103(a) as being unpatentable over Okada as applied to claims above, and further in view of U.S. Patent No. 6,085,020 to Saito et al. However, Saito et al. fails to make up for the deficiencies noted above in Okada et al. Saito et al. discloses a video editing apparatus that allows editing of a plurality of video clips. Video data stored on a hard disk drive is played back, and used to create an edit decision list (EDL). The EDL is created by selecting a start point and an end point of the necessary AV information material, and the resulting address information is recorded on the hard disk. The process can be repeated, after which the EDL is assigned a name and stored on a second hard disk. Significantly, Saito et al. fails to disclose Applicant's informative menus that identify each of the recorded programs in the menu using a title that refers to the subject matter or artistic content of the recorded program. Accordingly, Applicant respectfully submits that Claims 24, 32, and 36-37 are allowable. The remaining pending claims are believed to be allowable at least by virtue of their dependence upon an allowable base claim.

#### V. Conclusion

For the foregoing reasons, this entire application is believed to be in condition for allowance. Consequently, such action is respectfully requested. The Applicant requests that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Ser. No. 09/994,410  
Amdt. dated October 26, 2004  
Reply to Office action of May 5, 2004

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No fee is believed due. However, if a fee is due, please charge the additional fee to  
Deposit Account 07-0832.

Respectfully submitted,

By:   
Christine Johnson  
Reg. No. 38,507  
Phone (609) 734-6892

Patent Operations  
Thomson Licensing Inc.  
P.O. Box 5312  
Princeton, New Jersey 08543-5312  
October 26, 2004

CERTIFICATE OF MAILING

I hereby certify that this amendment is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, Alexandria, Virginia 22313-1450 on:

10/28/04  
Date

Lori M. Klewin